



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.132.231	08.11.1998	MARSHALL S. HORWITZ	032425-001	9035

21839 7590 07/26/2002

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 07/26/2002

42

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/132,231

Applicant(s)

HORWITZ ET AL.

Examiner

John S Brusca

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received
2. ☐ Certified copies of the priority documents have been received in Application No. ____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

Art Unit: 1631

DETAILED ACTION

1. The finality of the Office action mailed 12 March 2001 is withdrawn. The amendment filed 29 June 2001 after the final rejection has not been entered for reasons of record in the advisory action mailed 24 July 2001. The amendment filed 9 August 2001 after the final rejection has been entered. This Office action contains anew ground of rejection required by entry of the amendment filed 9 August 2001, and is a non-final Office action.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

Parent application 07/368674 filed 19 June 1989 discloses the invention of instant claim 28 at page 2, lines 10-14 and page 9, lines 6-8. However claimed parent application 06/887070, filed 17 July 1986 does not disclose the invention of instant claim 28, which is limited to a method utilizing polynucleotide sequences with a central preselected sequence and a randomized 5' and 3' sequence. Parent application 06/887070 only discloses polynucleotides with a central randomized sequence and predetermined 5' and 3' sequences, for example at pages 11-12, page 23, and pages 24-26.

Therefore the granted priority date is 19 June 1989 of parent application 07/368674.

Art Unit: 1631

Claim Rejections - 35 USC § 102

3. The rejection of claims 3, 4, 6, 13-18, and 21-26 under 35 U.S.C. 102(e) as being anticipated by Pieczenik in the Office action mailed 12 March 2001 is withdrawn in view of the amendment filed 9 August 2001.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Kauffman et al. (U.S. Patent No. 5,723,323).

The claim is drawn to a method of synthesizing a polynucleotide with a central preselected sequence and a randomized 5' and 3' sequence, and further expressing the polynucleotide and screening for a desired biological activity.

Kauffman et al. shows in columns 5 and 6 a method of synthesizing a polynucleotide with a central preselected sequence and a randomized 5' and 3' sequence. Kaufmann et al. shows on columns 2-3 that the polynucleotide can be expressed and screened for a variety of properties

Art Unit: 1631

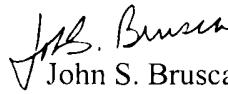
including enzymatic, biological, and chemical properties. Kauffman et al. terms such molecules as stochastic molecules. Kauffman claims in claim 1 a method of synthesizing stochastic polynucleotides and further expressing the polynucleotide and screening for a desired property.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 703 308-4231. The examiner can normally be reached on M_F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703 308-4025. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746-5137 for regular communications and 703 746-5137 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.


John S. Brusca
Primary Examiner
Art Unit 1631

jsb
July 18, 2002